

**REMARKS**

This is in response to the Office Action of February 23, 2009. Claim 6 is cancelled, without prejudice. The term “derivatives” is replaced by the more explicit term “compounds” throughout the claims. Claims 2-5 are amended to recite steps (i) – (iii) which were previously recited therein by reference to claim 1. New claim 13 is added, based upon original claim 1, but reciting the specific compounds recited in original claim 6. Claim 12 is replaced by claim 14, in order to provide more detailed  $\alpha$ -*N,N*-diBoc-aminoxyl- $\gamma$ -butyrolactone formulas. No new matter is introduced by this Amendment. Claims 1-5, 13, and 14 – all of which read on the elected invention of making chiral ( $\pm$ ) isomers – are pending in the application.

Claims 1-5 and 12 were rejected (under the second paragraph of 35 U.S.C. § 112) as failing to define the invention properly. As requested by the Examiner, the term “derivatives” has now been removed from the claims. It is respectfully submitted that persons skilled in the art would be apprised of the scope of Applicants’ invention by the language now in the claims (e.g., “method of preparing the chiral ( $\pm$ ) isomers of indole-2,3-dione-3-oxime compounds”). If the Examiner believes that such language would not be understood by persons skilled in the art, she is respectfully requested to provide an explanation as to what specific difficulty persons skilled in the art would have with the language in question. The Office Action indicates that “Applicants have deleted the ... steps in the claims, however they have not inserted the specific steps into the claims.” This is not the case. Claim 2, for instance, was amended as follows “(a) reacting enantiopure (*S*) or (*R*)  $\alpha$ -hydroxy- $\gamma$ -butyrolactone with *N,N*-diBoc-hydroxylamine to give enantiopure (*S*) or (*R*)  $\alpha$ -*N,N*-diBoc-aminoxyl- $\gamma$ -butyrolactone (~~Step 8a~~).” The name of the step (Step 8a) was removed from the claim, but the claim still recites the actual step (reacting A to give B). Applicants respectfully submit that each of claims 1-5, 13, and 14 herein is complete, and that persons skilled in the art would recognize whether a particular process is, or is not, encompassed by each of those claims. Nothing more is required by the second paragraph of 35 U.S.C. § 112. Therefore, withdrawal of the rejection of record is in order and is earnestly solicited.

Application No.: 10/524,441


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Please contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008 with any questions concerning the present application.

No fee is believed to be necessary in connection with this Amendment. If any fee is determined to be necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17.

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Respectfully submitted,

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